

REMARKS/ARGUMENTS

The Office Action dated December 19, 2008 has been carefully considered. With entry of this amendment, applicants believe this application is in condition for allowance. Accordingly, favorable reconsideration of the pending application as amended is respectfully requested in view of the following remarks.

Status of the Application

Claims 30-53 are currently pending with claims 30, 39, 41, 45, 46, and 48 amended herein. The Applicants note that amendments to claims 41, 45, and 46 merely fix a typographical error. As the subject matter of amended claims is fully supported by the application as filed, no new matter has been introduced into the application by way of these amendments.

Summary of the Office Action

Claims 30-53 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Claims 30-53 are also rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pub. No. 2003/0061093 to Todd (hereinafter “Todd”) in view of U.S. Pub. No. 2005/0055270 to Broe (hereinafter “Broe”) and U.S. Pub. No. 2002/0046110 to Gallagher (hereinafter “Gallagher”).

Discussion

The subject matter of the present application pertains generally to providing a web interface for the consumer to use in managing a rewards account that includes an option to redeem at least a portion of a rewards balance by electronic transfer to a bank account and an option to redeem at least a portion via a different redemption vehicle. *See* Application, pages 18-19. As discussed in further detail below, however, none of the cited references teach or suggest the foregoing web interface recited in all claims.

Furthermore, the Applicants respectfully note that the Office Action broadly rejects all claims, including all dependent claims having additional limitations, under the asserted

combination of Todd, Broe, and Gallagher, without referencing *any* of the particular features of each dependent claim as being allegedly present in the asserted combination and without articulating any reasons to combine these references to meet the limitations of dependent claims 31-38, 40-47, and 49-53. For instance, the Applicants respectfully request a clarification as to where in the asserted combination are there teachings of “initiating regular electronic funds transfers ... in the amount of the selected redemption amount according to the specified periodic time interval” or “initiating, in response to determining the threshold value has been exceeded, an electronic funds transfer ... in the amount of the threshold value” or “a user-selectable option to specify one of the one or more previously specified bank accounts identified in the retrieved records as the recipient of the electronic deposit,” as recited by claims 36, 37, and 38 respectively? Similarly, the Office Action does not specify as to how the asserted combination of Todd, Broe, and Gallagher teaches any of the elements recited in each of the rest of the dependent claims 31-35, 40-47, and 49-53. **Therefore, the Office Action has not met its burden under MPEP 2142 of establishing a *prima facie* case of obviousness in order to reject any of the dependent claims.** Rejections of these claims further fall short of the requirements for the contents of 35 U.S.C. 103 rejections set forth in MPEP 706.02 (j). For these reasons alone, allowance of dependent claims 31-38, 40-47, and 49-53 is earnestly requested. Sections of MPEP 2142 with respect to Examiner’s burden to properly establish a *prima facie* case of obviousness are reproduced below for Examiner’s convenience.

2142 Legal Concept of *Prima Facie* Obviousness [R6]

... **The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. ...**

ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS

****>The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). <**
MPEP 2142 (emphasis added).

35 U.S.C. 101 Rejections

With respect to the 35 U.S.C. 101 rejections of claims 30-53, independent claims 30 and 39 have been amended to recite the web interface being “presented by a financial transactions computer system over a network,” which conforms with the machine-or-transformation test enunciated in the recent Federal Circuit decision in *In re Bilski*, 545 F.3d 943 (Fed. Circ. 2008) by tying the steps of these claims to particular machines. Similarly, independent claim 48 has been amended to recite “a financial transactions computer.” See Application, page 9 (reciting a “network 107,” as well as a financial institution having a “computing device or system” 114 used to monitor transactions stored in the database 112 and calculate interest charges and cash rebate awards, among other things). See also, Application, Figure 1.

The Applicants further note that claims 30 and 48 already recite “a financial transactions network.” Claim 48 further recites a “web interface.”

Claims 31-38, 40-47, and 49-53 respectively incorporate all of the features of claims 30, 39, and 48 from which they depend and, therefore, meet the requirements of 35 U.S.C. 101 for at least the same reasons. Hence, the Applicants believe that the foregoing amendments have rendered rejections of claims 30-53 under 35 U.S.C. 101 as moot.

35 U.S.C. 103(a) Rejections

Claims 30-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd in view of Broe and Gallagher. As discussed above, while none of the additional limitations of dependent claims 31-38, 40-47, and 49-53 have been addressed in the Office Action, the Applicants further note that the asserted combination of Todd, Broe and Gallagher does not teach or suggest the use of a web interface for the consumer to use in managing a rewards account that includes an option to redeem at least a portion of a rewards balance by electronic transfer to a bank account, an option to redeem at least a portion via a different redemption vehicle, as well as provides the particular data exchange functionality recited in claims 30, 39, and 48.

Specifically, the Office Action relies on paragraphs 0038, 0046-0050, and 0067-0069 of Broe for the disclosure of the foregoing “web interface” functionality. However, the cited

paragraphs of Broe clearly discuss the consumer interfacing with a Point of Sale (POS) device that is “located on the premises of the independent merchant” for issuing (printing) rewards to the consumer. *See* Broe, par. 0069 (“POS device 112 being located on the premises of the independent merchant”). Furthermore, Broe requires the consumer to redeem the rewards printed via the POS device directly from another merchant and does not provide a redemption option via an electronic deposit to a bank account. Broe requires the consumer to “visit” the physical business establishment of a merchant to redeem the printed award and distinguishes physical “locations” of merchants for the same business establishment by type and price of goods sold by stating that the “*reward issued by the business establishment 911 (FIG. 9) could be redeemable at a location where less expensive goods are sold.*” *See* Broe, par. 0068 (also stating that “it is known that store chains selling the same general goods in the various outlets may sell more upscale goods in **upscale locations** and less expensive goods at locations located elsewhere.”) (emphasis added). *Since Broe also limits the consumer’s redemption options to particular physical store “locations” for a given merchant, allowing the consumer to redeem awards via a web interface would abrogate this express requirement of Broe and would render the disclosure of Broe non-functional.* Neither Todd nor Gallagher remedy the foregoing deficiencies of Broe. Hence, the asserted combination of Todd, Gallagher, and Broe does not teach or suggest redemption of awards via a “web interface,” as recited in claims 30, 39, and 48.

Dependent claims 31-38, 40-47, and 49-53 incorporate all of the requirements of their respective independent claims 30, 39, and 48 and therefore are also patentable for at least the same reasons.

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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